Remarks

In Paragraphs 1 and 2 of the pending Office Action, the Examiner set forth an election/restriction requirement. The Office Action restricts pending claims 9-13 as follows:

> Group I: claims 9 and 10, drawn to a method of preparing a pharmaceutical composition comprising providing a compound of formula A-B-C, wherein A is an amino acid, B is a chemical bond between A and C or is an amino acid, and C is an unstable inhibitor of DP IV, classified in class 530, subclass 330.
>
> Group II; claims 11-13, drawn to a method of treating disorders in mammals by modulating the DP IV enzymatic activity comprising administering a compound of A-B-C, classified in class 530, subclass 330.

In paragraph 1, the Examiner further states that pending claims 1-8 and 14 will be examined along with the elected invention.

Applicants provisionally elect, with traverse, Group II. According to Section 803 of the M.P.E.P., restriction may properly be required between patentably distinct inventions if (1) the inventions are independent or distinct as claimed; and (2) there is a serious burden on the Examiner if restriction is not required. In this case, the entire patent system would be unnecessarily burdened with the additional application required and the duplicative work this restriction demand entails.

Specifically, Applicants respectfully submit that there will not be a serious burden on the Examiner if restriction between the claims is not required because regardless of the claims prosecuted, the field of search for each of the identified species will substantially overlap, if not be identical to the other. A separate field of search is shown to exist only when one of the distinct subjects can be searched in places where no pertinent art to the other subject exists. In this case, however, there is no indication that a separate field of search is required for the distinct inventions. Thus, Applicants respectfully contend that there will not be a serious burden on the Examiner if restriction is not required.

Applicants additionally respectfully submit that the restriction requirement is improper under 37 C.F.R. 1.141 and M.P.E.P. § 806.05(i). 37 C.F.R. 1.141(b) reads as follows:

> (b) Where claims to all three categories, product, process of making, and process of use, are included in a national application, a three way requirement can only be made where the process of making is distinct from the product. If the process of making and the product are not distinct, the process of using may be joined with the claims directed to the product and the process of making the product even though a showing of distinctness between the product and the process can be made.

Further, M.P.E.P. § 806.05 (i) states the following:

> Where the product claims are allowable (i.e., novel and nonobvious), restriction may be required only where the process of making and the product made are distinct (M.P.E.P. § 806.05(f); otherwise, *the process of using must be joined with the process of making and the product made,* even if a showing of distinctness can be made between the product and the process of using (M.P.E.P. §806.05(h)) (emphasis added).

Applicants submit that the product claims (1-8 and 14) are novel and nonobvious and thus allowable; further, there is no basis here for determining that the process of making claims (9-10) and the product claims (1-8 and 14) are distinct inventions under M.P.E.P. § 806.05(f). Thus, the process of using must be joined with the process of making and the product made under M.P.E.P. § 806.05 (i), rendering this restriction requirement improper. Additionally, claims 11-13 (group II) cannot be practiced without also practicing claims 9-10 (group I). Again, restriction is improper; see M.P.E.P. § 806.05(i). For these reasons, Applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement.

Paragraph 1 further requires the selection of one of the diseases of claim 13. Applicants respectfully traverse this requirement, for the above reasons. While Applicants are most concerned with diabetes, Applicants would respectfully point out that all the diseases of claim 13 have a common etiology, namely, the mismanagement of DP IV activity. It is for this reason that they are thus characterized as being treatable "by modulating ... DP IV activity," as is described in the specification and in independent claim 11. This being the case, any differences in the specifics of the diseases are irrelevant. Furthermore, claim 11 is a generic claim which provides the basis for the diseases of claim 13; thus, it is submitted that the restriction requirement is

improper. For these reasons, Applicants respectfully request that the Examiner reconsider and withdraw this requirement.

As all submissions are being made within the time period specified by the Examiner for response, no fees are believed necessary in connection herewith.

The claims remaining within the application are believed to patentably distinguish over the prior art and to be in condition for allowance. Early and favorable consideration of this application is respectfully requested.

Respectfully submitted,

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